

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Brown et al.	§
Serial No.: 10/617,528	§ Group Art Unit: 3623
Filed: July 10, 2003	§ Examiner: Kardos, Neil R.
For: Consulting Assessment	§ Confirmation No.: 3557
Environment	§
	§

37945

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on September 16, 2009.

A fee of \$540.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0457. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

This appeal has no related proceedings or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are: 1-34.

B. STATUS OF ALL THE CLAIMS IN APPLICATION

Claims canceled: 8-20.

Claims withdrawn from consideration but not canceled: None.

Claims pending: 1-7 and 21-34.

Claims allowed: None.

Claims rejected: 1-7 and 21-34.

Claims objected to: None.

C. CLAIMS ON APPEAL

The claims on appeal are: 1-7 and 21-34.

STATUS OF AMENDMENTS

An Amendment was not filed after the Final Office Action dated August 13, 2009. Accordingly, the claims on appeal herein are as amended in the Response to Office Action filed on May 13, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to:

A method in a data processing system for providing a consulting assessment environment, the method comprising (Specification p. 3, lines 3-5);

a memory having a plurality of software instructions stored therein, the plurality of software instructions adapted to cause a processor of a computer to perform the steps of (Specification page 21, line 4 – page 22, line 2);

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client (Specification page 3, lines 5-12, figures 4, 5, and 6), and wherein self-assessment data is stored separately from the assessment business logic (Specification page 10, lines 7-12);

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising (Specification page 17, line 1 – page 18, line 29 and figure 5 elements 516, 518, 526, 530);

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations (Specification page 12, lines 9-13 and page 11, lines 1-9);

translating a plurality of hypotheses into interview questions for assessing a current state of a business (Specification page 12, lines 4-8); and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a

hiding feature (Specification page 10, lines 14-19);

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices (Specification page 12, line 29 – page 13, line 14, page 9, line 29 – page 10, line 2);

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template (Specification page 17, lines 13-29);

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses (Specification page 18, lines 14-19, page 12, lines 16-18); and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (Specification page 18, lines 25-29, page 12, lines 9-20), and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client (Specification page 10, lines 14-19).

B. CLAIM 21 – INDEPENDENT

The subject matter of claim 21 is directed to:

A computer program product in a computer readable storage medium for providing a consulting assessment environment, the computer program product comprising (Specification page 3, lines 3-5);

computer usable program code stored in the computer readable storage medium, wherein the computer usable program code is adapted to cause a processor in a computer to perform steps comprising (Specification page 21, line 4 – page 22, line 2);

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client (Specification page 3, lines 5-12, figures 4, 5, and 6), and wherein self-assessment data is stored separately from the assessment business logic (Specification page 10, lines 7-12);

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising (Specification page 17, line 1 – page 18, line 29 and figure 5 elements 516, 518, 526, 530);

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations (Specification page 12, lines 9-13 and page 11, lines 1-9);

translating a plurality of hypotheses into interview questions for assessing a current state of a business (Specification page 12, lines 4-8); and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature (Specification page 10, lines 14-19);

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices (Specification page 12, line 29 – page 13, line 14, page 9, line 29 – page 10, line 2);

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template (Specification page 17, lines 13-29);

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses (Specification page 18, lines 14-19, page 12, lines 16-18); and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (Specification page 18, lines 25-29, page 12, lines 9-20), and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client (Specification page 10, lines 14-19).

C. CLAIM 28 – INDEPENDENT

The subject matter of claim 28 is directed to

An apparatus for providing a consulting assessment environment, the apparatus comprising (Specification page 3, lines 3-5);

a processor, and instructions stored in a memory, wherein the instructions are adapted to cause the processor to perform a plurality of steps comprising (Specification page 21, line 4 – page 22, line 2);

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client (Specification page 3, lines 5-12, figures 4, 5, and 6), and wherein self-assessment data is stored separately from the assessment business logic (Specification page 10, lines 7-12);

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising (Specification page 17, line 1 – page 18, line 29 and figure 5 elements 516, 518, 526, 530);

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations (Specification page 12, lines 9-13 and page 11, lines 1-9);

translating a plurality of hypotheses into interview questions for assessing a current state of a business (Specification page 12, lines 4-8); and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature (Specification page 10, lines 14-19);

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices (Specification page 12, line 29 – page 13, line 14, page 9, line 29 – page 10, line 2);

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template (Specification page 17, lines 13-29);

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses (Specification page 18, lines 14-19, page 12, lines 16-18); and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (Specification page 18, lines 25-29, page 12, lines 9-20), and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client (Specification page 10, lines 14-19).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A. GROUND OF REJECTION 1

A rejection of claims 1-7 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

B. GROUND OF REJECTION 2

A rejection of claims 1-7 under 35 U.S.C. 101, because the claim invention is directed to non-statutory subject matter.

C GROUND OF REJECTION 3

Whether the examiner failed to state a *prima facie* obviousness rejection under 35 U.S.C. § 103 against claims 1-7 and 21-34 over Griffor, U.S. 2002/0173999 (“Griffor”), in view of MacDonald U.S. 2004/0068429 (“MacDonald”), and further in view of Nandigama, U.S. 2004/0010441 (“Nandigama”).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1-7)

The Examiner has rejected Claims 1-7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states:

Claim 1 is directed toward a method (process), wherein the method (process) comprises a memory. The term "process" in § 101 defines "actions" (i.e. a series of steps or acts to be performed). See MPEP 2106 (IV) (A). A memory is a step or act to be performed; thus, it is unclear how claim 1 is directed toward a method. Clarification is required.

Claims 2-7: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Final Office Action dated August 13, 2009, pp. 4-5.

The first two elements of Claim 1 state:

A method in a data processing system for providing a consulting assessment environment, the method comprising:
a memory having a plurality of software instructions stored therein, the plurality of software instructions adapted to cause a processor of a computer to perform the steps of:

Appellants' method is recited following "steps of" in the claim. The software instructions cause a processor to perform the steps. The software instructions are stored in memory and executed by the processor of a computer. Therefore, Appellants submit that the claim is not indefinite, and the rejection under 35 USC 112, second paragraph should be overruled.

B. GROUND OF REJECTION 2 (Claims 1-7)

The Examiner has rejected Claims 1-7 under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter.

The Examiner states:

Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.c. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a

different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Although the claim preamble recites that the method is "in a data processing system," this is merely an incidental physical limitation that is insufficient to tie the claimed process to a particular machine.

Although the claim has been amended to include a memory with software instructions that cause a processor to perform some steps, it is unclear how this memory is part of the claimed method (see § 112 rejection, above). Thus, the § 101 rejection has been maintained until this deficiency is corrected.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Final Office Action dated August 13, 2009, pp. 3-4.

The first two elements of Claim 1 state:

A method in a data processing system for providing a consulting assessment environment, the method comprising:
a memory having a plurality of software instructions stored therein, the plurality of software instructions adapted to cause a processor of a computer to perform the steps of:

Appellants submit that the claims are tied to a particular machine. Appellants' method is recited following "steps of" in the claim. The software instructions cause a processor to perform the steps. The software instructions are stored in memory and executed by the processor of a computer. Therefore, Appellants submit that the claim is tied to a particular machine, the processor as recited, and that the rejection under 35 USC 112, second paragraph should be overruled.

C. GROUND OF REJECTION 3 (Claims 1-7 and 21-34)

The Examiner has rejected claims 1-7 and 21-34 under 35 U.S.C. 103(a) as being unpatentable over Griffor, U.S. 2002/0173999 (“Griffor”), in view of MacDonald U.S. 2004/0068429 (“MacDonald”), and further in view of Nandigama, U.S. 2004/0010441 (“Nandigama”).

The Examiner bears the burden of establishing a prima facie case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

I. Claims 1, 21, and 28

Independent claims 1, 21 and 28 have similar elements. Claim 28 is representative and Appellants will address claim 28. The examiner rejected claim 28 for the same reasons as claim 1 and claim 21. Therefore, the arguments in regard to claim 28 apply equally to claims 1 and 21.

In regard to claims 1, 21 and 28, the Examiner cited to Griffor stating:

- determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic (see ¶ 15, disclosing recording and structuring information produced by the definition phase of the organizational consulting process; ¶ 18, disclosing decomposing an organization; ¶ 19, disclosing a definitional stage and an organizational framework; ¶ 20, disclosing "business rules logic"; ¶ 21, disclosing specification tables constructed

during the definitional phase of the consulting process; ¶ 23 et seq., disclosing specification tables; ¶ 51, disclosing an organizational definition) and conducting a self-assessment (see ¶ 16, disclosing an assessment of an organization to align the organization with its purpose; ¶ 19, disclosing determining success based on actual performance; ¶ 21, disclosing storing performance data; ¶ 22, disclosing allowing participants to give feedback on their individual performance), wherein defining assessment business logic is performed by a consultant (see above-cited sections; figure 2), wherein conducting a self-assessment is performed by the consultant or a client (see above-cited sections; figure 2), and wherein self assessment data is stored separately from assessment business logic (see figure 3: item 64, disclosing an organizational performance database, and items 62-63, disclosing action rules and specification tables databases that store business logic; ¶ 6, disclosing separate databases for logic and performance; ¶¶ 20-21);

- responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses (see sections cited below, particularly ¶¶ 4, 6, 19-21, and 23-52, disclosing creating and linking specification tables that serve as data templates for assessments and action rules),

further comprising:

- encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations (see ¶¶ 4, 6, 19-21, 23-52, and 65-66; the reference discloses creating specification tables [¶ 23 et seq.] with weights [¶¶ 25-26], formulas [¶¶ 43, 46, 48, and 49], and action rules [¶ 50] that define how the assessment data is used to generate results [¶ 23, recording the results; ¶¶ 41-43, value assessment; ¶ 50] and recommendations [¶ 65, disclosing recommendations for improvement]);

- translating a plurality of hypotheses into interview questions for assessing a current state of a business (see ¶¶ 79-81, disclosing an interview question addressing what changes could be made in order to improve an element of the organizational goals; see also ¶¶ 54-64 and 72-76, disclosing interview questions based on the most commonly-asked questions);

- responsive to determining that the intended use is conducting a self-assessment, receiving self-assessment data about the business through a questionnaire (see ¶¶ 17-18, disclosing determining the organization's goals, etc.; ¶ 23 et seq., disclosing gathering information generated during the definition phase; ¶¶ 28-31; ¶ 77; figure 2: items 1-4);

- responsive to receiving the self-assessment data about the business, computing at least one assessment score based on formulas and rules encoded in the assessment framework template (see ¶ 19, disclosing quantitatively measuring the importance of deliverables; figure 5, depicting relative value and total value; various figures disclosing point values; ¶¶ 41-50; ¶ 79; ¶ 82)

- responsive to computing the at least one assessment score, determining an

appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of business (see ¶¶ 19 and 21, disclosing actions rules used to maintain alignment between performance and goals; ¶ 22, disclosing action rule module that provides actions to be taken to help achieve organizational goals; ¶ 50, disclosing constructing action rules based on weights; ¶¶ 65-66; ¶ 82)

- reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (see ¶¶ 54-58, disclosing a management module which provides reports to management; ¶¶ 59-64, disclosing a participant module which provides reports to workers; ¶¶ 72-80).

It is not explicitly clear whether Griffor discloses the claimed "templates" for storing data (although Griffor does disclose specification tables). MacDonald discloses a similar consulting system for strategic performance management that uses templates in the form of Microsoft Excel spreadsheets (see ¶ 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to record the information of Griffor in the templates of MacDonald. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Further, Griffor does not explicitly disclose wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices. Nandigama discloses this limitation (see figure 5). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to store questions in a template. It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the questions asked by Griffor according to a template (such as that in Nandigama or those known in the art). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Griffor does not explicitly disclose encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template. However, these limitations are not sufficient to distinguish the claimed invention over the prior art because Griffor manipulates data in the same way as the claimed invention. In other words, the recited method steps would be performed in the same manner regardless of whether or not proprietary information and trade secrets are encoded into the templates. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed.

Cir.1994); *MPEP 2106*. Griffor does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security. Furthermore, Examiner notes that Applicant has failed to traverse Examiner's Official Notice, which was originally set forth in the previous Office action. Therefore, the above findings of Official Notice are taken to be admitted prior art. See *MPEP* § 2144.03 (C).

Examiner also notes that MacDonald and Nandigama also disclose many of the above limitations that Griffor has been shown to disclose.

Final Office Action dated August 13, 2009, pp. 5-13.

All words in each independent claim must be considered in order to properly evaluate the claim in light of the prior art. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Appellants submit that each independent claim, when considered as a whole, distinguishes over the cited art. Claim 28 will be discussed as a representative claim.

To explain how Claim 28 distinguishes over the cited art, Appellants will discuss the claim in terms of two modes which shall be called a first mode and a second mode. Appellants submit that the two modes, as they cooperate together, form a higher level consulting environment, and that higher level consulting environment cannot be disclosed by the cited art, individually or in combination. The higher level consulting environment creates tools in a first mode independently of the particular organization to which they will be applied in the second mode. Moreover, the tools created in the first mode are created to include consultant knowledge independently of the particular business. In order to explain how the entire claim acts together to distinguish over the cited art, the terms first mode and second mode are used to show the relationship of the multiple elements of the claim and so avoid lengthy repetitive quotations from the claim. To explain the modes, representative claim 28 is set forth below in a table.

Claim 28 Higher Level Environment Mode Cooperation Analysis

Claim 28	Explanation of the cooperation of two modes to produce a higher level consulting environment than that of the prior art
a processor, and instructions stored in a memory, wherein the instructions are adapted to cause the processor to perform a plurality of steps comprising:	
determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein self-assessment data is stored separately from the assessment business logic;	When the intended use is “defining assessment business logic” the assessment business logic is “performed by a consultant.”
responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising:	For analysis these steps will be referred to as First mode. The “responsive to” step and the following steps discussed in the box below shall be referred to as First Mode steps for analysis. The consultant (see “performed by a consultant”) defines a data template, an assessment framework, a suggested actions template, and a report template.” Defining these tools creates “assessment business logic” The assessment business logic is “for multiple types of assessments for assessing businesses.”
encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations;	All of these elements further limit “defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments.” Thus the “encoding” element, the “translating element” and the second “encoding” element are all performed by the consultant “for multiple types of assessments for assessing businesses.”
translating a plurality of hypotheses into interview questions for assessing a current state of a business; and	
encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the	

proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature;	
responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices;	<p>For analysis, these steps will be referred to as Second mode.</p> <p>Second mode steps take place after the first mode (see above) is performed. In the second mode, the tools created by the consultant are used to determine an assessment score and an appropriate action for a particular business.</p>
responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template;	
responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses; and	
reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client.	<p>The resulting report is a second mode action, but cannot take place without the separate operations of the first mode which must take place prior to the second mode, and which are performed by the consultant independent of the particular business involved in the second mode. Moreover, consultant knowledge, used to create tools in the first mode is defined by the wherein clause “wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals.”</p>

Thus, as explained in the table above, claim 28, in its entirety, provides a higher level consulting environment than the cited art, individually or in combination. By higher level consulting environment is meant that the elements of claim 28 can be analyzed in two portions or modes which operate in a definite sequence, a first mode preceding a second mode. In addition, the

second mode cannot be performed until the first mode is completed. Moreover, the first mode is performed by a consultant only without any interaction with the particular business to which the first mode will be applied.

Moreover, the first mode elements incorporate consultant knowledge independent of the particular business. The consultant creates, *inter alia*, three tools that are used to create a report. The three tools are (1) the data template, (2) the assessment framework template, and the (3) suggested actions template. The three tools “encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals.” But the creation of the tools with the consultant’s knowledge of encoded best practices, business consultant expertise, and business goals is performed by the consultant before the tools are applied to a particular business to produce a report. In other words, the tools are created by a consultant for a plurality of businesses, and those tools are then used to produce a report for a particular business.

Thus, in claim 28 the consultant *first* creates business templates for a plurality of businesses. The clause of claim 28’s last element, “wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals,” indicates that the consultant uses knowledge independent of the particular business to which the templates are applied in the second mode elements.

Claim 28’s templates are created and ready to provide a framework, a questionnaire, a suggested action, a report template with formulas and logic rule definitions, and hidden proprietary information and trade secrets in a first mode so that all are created and ready at a time in the first mode elements that precedes using the templates for a particular client assessment in the second mode elements. Moreover, the tools are created in the first mode using the consultants’ knowledge. By the consultant’s knowledge is meant that knowledge recited as being encoded in the templates as set forth in “wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals.” The consultants’ knowledge is applied in the first mode independently of the particular business acted on in the second mode.

Griffor does not disclose creation of the tools in a first mode as those elements are set forth in claim 28 because *Griffor* does not create its tools independent of the “particular

business” to which the disclosure is directed. *Griffor* could not disclose such creation of tools independent of the “particular business” because *Griffor*’s process specifically begins by defining a “particular” organization’s goals, and then generating templates to apply to the particular business. Moreover, *Giffor* is explicit that the process is directed to one organization and its sub-elements. Specifically, *Griffor* teaches starting the consulting process at a particular organization to determine the particular organization’s goals. *Griffor* then performs an assessment of the particular organization’s adherence to those goals. The evidence shows that *Griffor* is directed only to this particular organization and is not directed to a consultant creating tools through a series of first mode steps performed independently of a particular organization.

Griffor’s lack of first mode elements as set forth in claim 28 is evidenced in *Griffor*’s paragraphs [0017], [0018], and [0019]. *Griffor*’s paragraph [0017], states “[t]he consulting process of FIG. 1 involves a determination of the organization’s goals, followed by a breakdown of those goals into successively more detailed levels of implementation until they are completely decomposed into a set of deliverables and individual roles for participants within the organization.” *Girffor*’s paragraph [0018] states “[i]n terms of the consulting process, the organizational goals can be embodied in a statement that addresses three different sectors -vision, mission, and philosophy of the organization.” *Griffor* further states in paragraph [0018] “[t]his breakdown, or decomposition, continues until specific deliverables have been determined, at which point the deliverables are used to determine the individual roles required of the participants within the organization” and “[f]inally, the tactical and operational elemental components are tied to the organization’s infrastructure so that they can be separated into the specific deliverables required of the various participants, processes, and systems of the organization. In paragraph [0019], *Giffor* states: “[a]s shown in FIG. 2, information arising out of this consulting process is captured at each definitional stage (i.e., at each level of elemental components) by a computer-based system that records, manages, and processes the information in a manner which enables the system to assist the performance management of the organization in a number of different ways....”

As can be seen by analyzing the foregoing paragraphs of *Griffor*’s specification, only a singular and particular “organization” is acted upon and the “deliverables” are created for that organization at the time that the consultant interacts with the particular organization. Thus *Griffor*

teaches a consulting process that begins by *first* determining a particular organization's goals, represented by a set of the organizations deliverables. As shown above, the consulting process of *Griffor* begins by *first* determining the particular organization's goals then assessing the particular organization's progress toward the organization's goals.

Thus *Griffor* does not direct the consultant to first create a set of templates for determining a plurality of business assessments for a plurality of businesses based on the consultant's knowledge independently of the particular organization. Instead of the consultant first creating templates independently of a particular business, *Griffor* directs the consultant to create templates specifically directed and optimized for the one particular organization. *Griffor* cannot be used alone or with other art to disclose all limitations of claim 28 because *Griffor* focuses inwardly on the goals of the organization and does not teach or suggest a consultant pre-building a collection of templates using the consultant's business knowledge.

Furthermore, the Examiner states in his rejection that "*Griffor* does not explicitly disclose encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template" but that "... these limitations are not sufficient to distinguish the claimed invention over the prior art because *Griffor* manipulates data in the same way as the claimed invention." As explained above *Griffor* does not manipulate data in the same way as Appellants claim 28 because *Griffor* lacks creation of the tools in a first mode, performed independently of the particular business to which the templates are applied, and without application of the consultant's knowledge.

Additionally neither *MacDonald* nor *Nandigama* remedy the failure of *Griffor* to teach or suggest all of these of features of claim 28. *MacDonald* discloses a system and method for developing a strategic organization plan using a specific "Balanced Business Scorecard" system which is presented and processed on Microsoft Excel spreadsheets (abstract and paragraph 36). *Nandigama* discloses a method and system for mapping metrics to goals of an organization in order to track process improvement of the organization (abstract). The combination of *Griffor*, *MacDonald* and *Nandigama* do not teach or suggest the consulting assessment environment disclosed by claim 28. Therefore, the Examiner failed to state a prima facie obviousness rejection against claim 28. As stated above, the arguments for claim 28 apply equally to claims 1 and 21.

In addition, *Griffor*, *MacDonald*, and *Nandigama*, taken alone or in combination, do not teach or suggest the features of dependent claims 29-34 at least by virtue of their dependency on claim 28.

II. Claims 1-8 and 21-27

Claims 1-8 are method claims and claims 21-27 are program product claims that contain the same subject matter of the apparatus claims 28-34. Therefore, *Griffor*, *MacDonald*, and *Nandigama*, taken alone or in combination, do not teach or suggest the features of claims 1-8 and 21-27 for the same reasons discussed above.

D. CONCLUSION

As shown above, the examiner has failed to state valid rejections against any of the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the examiner to allow the claims.

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Respectfully submitted,

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CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

1. A method in a data processing system for providing a consulting assessment environment, the method comprising:

a memory having a plurality of software instructions stored therein, the plurality of software instructions adapted to cause a processor of a computer to perform the steps of:

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein self-assessment data is stored separately from the assessment business logic;

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising:

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations;

translating a plurality of hypotheses into interview questions for assessing a current state of a business; and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template,

wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature;

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices;

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template;

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses; and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client.

2. The method of claim 1 further comprising:

determining the current state of the business based on the self-assessment data;

identifying a desired state for the business using the assessment framework template and the suggested actions template to analyze the self-assessment data and to determine new business insights and recommendations for the business; and

performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business using the suggested actions template.

3. (The method of claim 1 further comprising:

identifying benefits and risks for the current state of the business and for moving to a desired state of the business based on the at least one assessment score and the appropriate action.

4. The method of claim 1 further comprising:

consolidating portions of the results together for further analysis, wherein the appropriate action is determined for a particular division or unit of the business.

5. The method of claim 1 further comprising:

providing an interface for the client to conduct the self-assessment to gather the self-assessment data about the business, wherein the self-assessment data is used to determine the current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state of the business in real time.

6. The method of claim 1, wherein the data template includes at least one of the interview questions, weighing factors, desired states, benefit descriptions, risk descriptions, suggested actions, cost areas, and terminology.

7. The method of claim 1, wherein the assessment framework template includes at least one of scoring information, calculations, suggested actions logic, benefit and risk logic, user feedback, and user input.

21. A computer program product in a computer readable storage medium for providing a consulting assessment environment, the computer program product comprising:

computer usable program code stored in the computer readable storage medium, wherein the computer usable program code is adapted to cause a processor in a computer to perform steps comprising:

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein self-assessment data is stored separately from the assessment business logic;

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising:

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations;

translating a plurality of hypotheses into interview questions for assessing a current state of a business; and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature;

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices;

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template;

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of businesses; and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the

assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client.

22. The computer program product of claim 21 further comprising:

determining the current state of the business based on the self-assessment data;

identifying a desired state for the business using the assessment framework template and the suggested actions template to analyze the self-assessment data and to determine new business insights and recommendations for the business; and

performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business using the suggested actions template.

23. The computer program product of claim 21 further comprising:

identifying benefits and risks for the current state of the business and for moving to a desired state of the business based on the at least one assessment score and the appropriate action.

24. The computer program product of claim 21 further comprising:

consolidating portions of the results together for further analysis, wherein the appropriate action is determined for a particular division or unit of the business.

25. The computer program product of claim 21 further comprising:
providing an interface for the client to conduct the self-assessment to gather the self-assessment data about the business, wherein the self-assessment data is used to determine the current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state of the business in real time.
26. The computer program product of claim 21, wherein the data template includes at least one of the interview questions, weighing factors, desired states, benefit descriptions, risk descriptions, suggested actions, cost areas, and terminology.
27. The computer program product of claim 21, wherein the assessment framework template includes at least one of scoring information, calculations, suggested actions logic, benefit and risk logic, user feedback, and user input.
28. An apparatus for providing a consulting assessment environment, the apparatus comprising:
a processor, and instructions stored in a memory, wherein the instructions are adapted to cause the processor to perform a plurality of steps comprising:
determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic and conducting a self-assessment, wherein defining assessment business logic is performed by a consultant, wherein conducting a self-assessment is performed by the consultant or a client, and wherein self-assessment data is stored separately from the assessment business logic;

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising:

encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations;

translating a plurality of hypotheses into interview questions for assessing a current state of a business; and

encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature;

responsive to determining that the intended use is conducting a self-assessment, receiving the self-assessment data about the business through a questionnaire, wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices;

responsive to receiving the self-assessment data about the business, computing at least one assessment score based on the formulas and the logic rule definitions encoded in the assessment framework template;

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded

with business-related domain knowledge that defines actions to achieve desired states of businesses; and

reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals, and wherein the proprietary information and the trade secrets of the consulting assessment environment are hidden from the client.

29. The apparatus of claim 28 further comprising:

determining the current state of the business based on the self-assessment data;

identifying a desired state for the business using the assessment framework template and the suggested actions template to analyze the self-assessment data and to determine new business insights and recommendations for the business; and

performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business using the suggested actions template.

30. The apparatus of claim 28 further comprising:

identifying benefits and risks for the current state of the business and for moving to a desired state of the business based on the at least one assessment score and the appropriate action.

31. The apparatus of claim 28 further comprising:
consolidating portions of the results together for further analysis, wherein the appropriate action is determined for a particular division or unit of the business.
32. The apparatus of claim 28 further comprising:
providing an interface for the client to conduct the self-assessment to gather the self-assessment data about the business, wherein the self-assessment data is used to determine the current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state of the business in real time.
33. The apparatus of claim 28, wherein the data template includes at least one of the interview questions, weighing factors, desired states, benefit descriptions, risk descriptions, suggested actions, cost areas, and terminology.
34. The apparatus of claim 28, wherein the assessment framework template includes at least one of scoring information, calculations, suggested actions logic, benefit and risk logic, user feedback, and user input.

EVIDENCE APPENDIX

This appeal brief presents no additional evidence.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.